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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

IWI-16117

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

10/541,772

Filed

July 8, 2005

First Named Inventor

Hideo Hata et al.

Art Unit

1616

Examiner

Ali Soroush

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Mark E. Bandy/

Signature

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Mark E. Bandy

Typed or printed name

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April 7, 2010

Date

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	10/541772	Confirmation No.	1465
Applicant	:	Hideo Hata et al.		
Filed	:	July 8, 2005		
TC/A.U.	:	1616		
Examiner	:	Ali Soroush		
Title	:	Water-Swellable Clay Mineral Laminated Powder, Dye- Water-Swellable Clay Mineral Complex And Composition Containing The Same		
Docket No.	:	IWI-16117		
Customer No.	:	007609		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

(In response to Paper No./Mail Date 20091205 and 20100315)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir/Madam:

Applicant hereby presents this Pre-Appeal Brief Request for Review in the above captioned application. A Notice of Appeal is filed concurrently herewith.

A previously filed Pre-Appeal Brief Request for Review was not considered because an "amendment" was included. That amendment was merely the cancellation of claims 1-31 so that the rejection of claims 32-39 could be specifically addressed via a Pre-Appeal Brief Conference.

In the Office Action mailed December 10, 2009, the Examiner maintained the rejection of claims 1-39 under 35 USC §103(a) for alleged obviousness based upon JP 358124713 to Mizumaki et al. (Japanese Patent 358124713) in view of van Duffel et al., and further in view of US 2003/0163877 to Baker et al.

This Pre-Appeal Brief Request for Review is submitted for claims 32-39.

Applicant respectfully requests the Panel to consider the outstanding rejection of claims 32-39.

#### **A. The Pending Claims**

Claim 32 is directed to an acid dye laminated pigment, in which a dye/water-swallowable clay mineral complex having an opposite charge to the charge of a base powder, is coated on the surface of the base powder, and a polybase and an acid dye are intercalated in between the layers of the water-swallowable clay mineral of the dye/water-swallowable clay mineral complex. Dependent claims 33-36 recite various aspects of the pigment of claim 32. Dependent claim 38 recites a pigment composition that includes the acid dye laminated pigment of claim 32. And dependent claim 39 recites a cosmetic that includes the acid dye laminated pigment of claim 32.

Claim 37 recites a method of producing an acid dye laminated pigment comprising an acid dye/water-swallowing clay mineral complex producing process for an acid dye intercalated in between the layers of the water-swallowable clay mineral. In this method, a polybase and an acid dye are contacted with a water-swallowable clay mineral in aqueous phase. The method also comprises a laminating process for the acid dye/water-swallowing clay mineral complex electrostatically adsorbed on the surface of a base powder. The obtained acid dye/water-swallowing clay mineral complex and a base powder, having an opposite charge to the charge of the complex, are mixed in aqueous phase.

**B. Rejection of Claims Under §103 Based Upon Mizumaki et al. in View of Van Duffel et al. and Baker et al. is Clearly Erroneous and Must be Withdrawn**

The pending claims 32-39 all relate to a dye/water-swellaable clay mineral complex which is significantly different than laminated powder. However, the Examiner did not mention the dye/clay mineral complex in the latest Office Action. Instead, the Examiner referred to the laminated powder. Specifically, it is respectfully submitted that the Examiner did not appreciate the subject matter of claims 32-39. In the most recent Office Action, the Examiner asserted:

Applicant claims a water-swellaable clay mineral laminted powder, in which a layer of ionic molecule having two or more ionic functional group is laminated on the surface of a base powder particle; a layer of water-swellaable clay mineral is laminated thereon.

Page 3 of Office Action mailed December 10, 2009.

It is believed that the Examiner was referring to the subject matter of previously presented claims 1-18. Those claims are directed to a laminated powder. That laminated powder is laminated water-swellaable clay and an ionic molecule (including polybase). That laminated powder is distinguishable from the subject matter of claims 32-39 relating to an acid dye laminated pigment that comprises a polybase between layers of water-swellaable clay (referred to as "intercalation"). In the laminated powder of claims 1-18, the ionic molecule is not intercalated in water-swellaable clay. This significant difference was noted in Applicant's previous Amendment B. However, this was not addressed in the most recent Office Action. For at least this reason, a prima facie rejection of claims 32-39 has not been made, and therefore, the present rejection must be withdrawn.

Furthermore, the prior art completely fails to teach or describe the claimed complexes and in particular, the intercalation aspect recited in all claims 32-39. Van Duffel et al. disclose a film formed by laminating an ionic molecule (PDDA) and water-swallowable clay mineral onto "mica". A close reading of the article to van Duffel reveals that "mica" refers to a "mica slide" as described in the experimental section of the article to van Duffel. The "mica slide" is a typical substrate used in AFM imaging. Van Duffel used the "mica slide" merely for AFM imaging, see for example that their article is entitled "Multilayered Clay Films: Atomic Force Microscopy Study and Modeling." (Emphasis added). The "mica slide" is a plate having a dimension in the range of centimeters or millimeters, and thus the "mica" is not powder. This article is not relevant to the pending claims.

In the JP '713 reference, Mizumaki used "mica powder" as a component of colored aerosol for a hair coloring agent. A person skilled in the relevant art and interested in devising an acid dye laminated pigment by a particular film forming technique, would not be motivated to use a "mica slide" as disclosed by van Duffel in a hair coloring agent as described by Mizumaki. These two teachings are from vastly different fields of art.

Nor would the skilled person be motivated to coat a clay mineral onto the mica powder of Mizumaki even in view of the teaching by Baker et al. in the US '877 publication. Baker teaches a hair coloring composition which contains a water-swallowable clay mineral and a coloring agent. It appears that the clay mineral and the coloring agent are attached to each other by their charge interaction. Baker teaches that the hair coloring composition has good color delivery to hair and reduced coloration

of the skin. However, if a person skilled in this field of art intended to combine Mizumaki and Baker, then he or she would blend the mica and the clay mineral-coloring agent complex separately into composition. There is no suggestion to coat the clay mineral complex onto the base powder, as called for in the pending claims.

Specifically, the art fails to teach an acid dye laminated pigment in which a dye/water-swellable clay mineral complex is coated on the surface of a base powder wherein a polybase is intercalated in between the layers of the water-swellable clay mineral of the complex.

For at least these reasons, it is respectfully submitted that all claims 32-39 are patentable over the cited references.

### **C. Conclusion**

If there are any fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. IWI-16117.

Respectfully submitted,

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